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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,014	06/25/2001	Michael D. Crandall	54185USA8B.014	9951

32692 7590 06/09/2003

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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 06/09/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

A9-11

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 5/2/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 5, 7, 8, 10, 11, 16-35 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 33-35 is/are allowed.
- ☒ Claim(s) 21-32 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 30-32 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, in independent claim 32 applicants appear to essentially repeat themselves at lines 13-16 of the claim from what previously was set forth at lines 5-9 regarding what elements comprise the reaction product of the particular microspheres and what elements may exist in an independent state. Clarification is requested.

3. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the invention. More particularly, as was mentioned in the interview (Paper No. 8), the Examiner has been unable to find any sort of enabling description with respect to the term "solid" microsphere and consequently fails to understand just what this term means, even though it has been used before in the patent literature. For example, does "solid" mean "free of porosity", or the like? Clarification is requested.

4. Claims 22 and 24 are rejected under 35 U.S.C. § 112, first paragraph as being based upon a non-enabling description.

5. Claims 21-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Coopridner et al. -617 taken individually for claims 21, 22, and 25-32, or in view of Le Fevre for claims 23 and 24, substantially for the reasons set forth in paragraph No. 3 of Paper No. 7, together with the following additional observations. Initially it is noted that applicants admit that independent claim 21 corresponds to previous claim 7, and the only other independent claim, claim 30 corresponds to previous claim 11, each of these former claims having been cancelled. Applicants have vigorously argued (Response, pages 8-9) that Coopridner et al. fails to teach a microsphere adhesive composition that includes a chain transfer agent, and also that to utilize a chain transfer agent lacks "requisite suggestion or motivation for modifying the microsphere adhesive". The Examiner initially notes (as applicants do not apparently contest) that Japanese Patent Abstract -136 and the Concise Encyclopedia of Polymer Science and Engineering are not contested for the fact that chain transfer agents are well known in the polymer art such as the pressure sensitive acrylic adhesive art particularly focused on by JP -136. Additionally, the Examiner respectfully submits that it is well known in the polymer adhesive art that chain transfer agents by regulating the length of the polymer

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chains of the particular composition control the amount of adhesiveness the resulting polymer composition exhibits. More particularly, if the adhesive chains are made shorter ~~for~~ the utilization of a greater amount of chain transfer agents, the adhesiveness of the composition will increase, and vice versa. Accordingly, the Examiner must respectfully submit that the utilization of such chain transfer agents in adhesive compositions to regulate the adhesion of the resulting composition is extremely well known in the art. With respect to the dependent claims, the performance parameter of claim 25 is believed to be, if not inherently present, at most an obvious optimization to one of ordinary skill depending upon the particular adhesive strength desired and what other parameters that are seen to exist are each believed to be, if not expressly or inherently disclosed, obvious modifications to one of ordinary skill, in the absence of unexpected results.

6. Claims 33-35, each of which require the separate presence of polyacrylamide in the adhesive composition are allowed.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also the parent application, U.S. 6,296,932B1 to Crandall et al.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel

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Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

June 3, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1300~~
1700

Daniel Zirker